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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,879	02/16/2007	Thomas Chapman	784-115 (188273)	8434
30448	7590	07/27/2009	EXAMINER	
AKERMAN SENTERFITT P.O. BOX 3188 WEST PALM BEACH, FL 33402-3188			FINEMAN, LEE A	
			ART UNIT	PAPER NUMBER
			2872	
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			07/27/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip@akerman.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,879	<b>Applicant(s)</b> CHAPMAN, THOMAS	
	<b>Examiner</b> LEE FINEMAN	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 17-22 is/are rejected.
- 7) ☒ Claim(s) 12-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/17/06 & 4/29/09 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is in response to an amendment filed 29 April 2009 in which claim 7 was amended. Claims 1-22 are pending.

After careful review of the claims, it is found that a further rejection is appropriate for claims 4-11 and 17-21. The examiner regrets any inconvenience caused by this action.

#### ***Specification***

1. The disclosure is objected to because of the following informalities: on page 7, line 19 "figure 7" should be --figure 6--.

Appropriate correction is required.

#### ***Claim Objections***

2. Claims 5-16 are objected to because of the following informalities:

Regarding claim 5, the limitation "the rear eyepiece" lacks antecedent basis. The dependent claims inherit the deficiencies of the claims from which they depend. Appropriate correction is required.

#### ***Declaration***

3. The declaration filed on 29 April 2009 under 37 CFR 1.131 is sufficient to overcome the Bodo (US 2005/0132631 A1) reference.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 17-18 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Avizonis, Jr. US 6,643,969 B1 (henceforth Avizonis).

Regarding claim 1, Avizonis discloses in figs. 5 and 6 a viewing device (1) that includes a main body (3 and 5), a first reflective surface (9), a second reflective surface (7), a means (23) adapted for removably securing said body to a sighting device (LS), wherein the first and second reflected surfaces are contained within the body (fig. 5), the first reflective surface (9) adapted to direct an incoming light beam from a first aperture (A<sub>1</sub>) to the second reflective surface (7), wherein the first and second reflective surfaces are not positioned parallel to one another (fig. 5), and the second reflective surface adapted to direct the reflected light beam at an angle of between 35 degrees and 60 degrees (column 4, lines 35-40) relative to the incoming light beam through a second aperture (A<sub>3</sub>) for viewing by a user (column 4, lines 31-35).

Regarding claim 22, Avizonis discloses a method of viewing around an obstacle (column 4, lines 31-35) including: (a) providing a viewing device (1) that includes a main body (3 and 5), a first reflective surface (9), a second reflective surface (7), a means (23) adapted for removably securing said body to a sighting device (LS), wherein the first and second reflected surfaces are contained within the body (fig. 5), the first reflective surface (9) adapted to direct an incoming light beam from a first aperture (A<sub>1</sub>) to the second reflective surface (7), wherein the first and

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second reflective surfaces are not positioned parallel to one another (fig. 5), and the second reflective surface adapted to direct the reflected light beam at an angle of between 35 degrees and 60 degrees (column 4, lines 35-40) relative to the incoming light beam; (b) mounting said viewing device onto a rear most section of the sighting device (figs. 7 and 8); (c) then viewing the reflected light beam through a rear of the body such that a head of a user looking through the viewing device is not substantially inline with the incoming light beam (column 4, lines 31-35).

Regarding claims 17-18, Avizonis further discloses wherein the body of the viewing device is constructed from high impact resistant material (in at least so far as the material has a higher impact than other materials like glass; and wherein the sighting device (LS) is a conventional riflescope (column 3, lines 3-4).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avizonis.

Regarding claims 2-5, Avizonis further discloses wherein the second reflective surface (7) is positioned at an angle of less than 90 degrees relative to a plane perpendicular to the incoming light beam (fig. 5); and wherein the viewing device is removably secured (via 23) to a conventional sighting device (column 3, lines 3-4) as well as that many other angles may be employed as desired (column 4, lines 37-38), but does not explicitly state that the second

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reflective surface is positioned to direct the reflected light beam at an angle of between 40 degrees and 55 degrees and more specifically 50 degrees relative to the incoming light beam and that the conventional sighting device has a rear eyepiece. Official notice is taken that it is very well known for weapon sights like riflescopes to have a rear eyepiece. It would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the viewing device to the rear eyepiece of the conventional sighting device to relay the appropriately focused image to the eye. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to change the positioning of the second mirror to employ different angles including the claimed 50 degrees, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. One would have been motivated to change the positioning of the second mirror to employ different angles for the purpose of to adapt the viewing device to a particular cover situation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) See also In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claims 6-10, Avizonis as set forth above further teaches in figs. 7 and 8 wherein the viewing device is removably secured to the rear eyepiece of a conventional sighting device by a friction fit (see column 4, line 41-column 5, line 11); wherein the incoming light beam (from A<sub>1</sub>) is directed to a side of the weapon (fig. 5) on which the viewing device is mounted; wherein the viewing device can be readily rotated about the sighting device, to direct the incoming light beam to either side of the weapon (see column 4, line 41-column 5, line 11); wherein the means adapted to removably secure the viewing device to a sighting device is a clip

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(27') adapted to hold the viewing device with positive engagement to the sighting device; and wherein the reflective surfaces are mirrors (column 3, line 15).

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Avizonis in view of Fantone, US 5,526,177.

Avizonis discloses the claimed invention except for wherein relay lenses are incorporated into the viewing device to provide eye relief. Fantone teaches in fig. 8 and column 5, lines 51-67 incorporating relay lenses into a viewing unit to maintain a sharp focus when viewing over the longer distance which provides eye relief in that the image is easier to view. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add relay lenses to the viewing unit of Avizonis to maintain a sharp focus of the image (Fantone, column 5, lines 51-67).

9. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avizonis in view of Giuffre et al., US 5,054,225 (henceforth Giuffre).

Avizonis discloses the claimed invention except for wherein an imaging apparatus can be attached to a rear of the body to capture the reflected light path; wherein the imaging apparatus is a fiber optic cable; and wherein the imaging apparatus is a device that generates video images. Giuffre teaches in figs. 1-4 adding an imaging apparatus (22 or 50) can be attached to a rear of the body to capture the reflected light path; wherein the imaging apparatus is a fiber optic cable (22); and wherein the imaging apparatus is a device that generates video images (50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to

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add the imaging apparatus of Giuffre to the viewing device of Avizonis to be able to aim the device without the need to maintain a constant distance of a head position in relation to the optical portion of the aiming device (Giuffre, column 1, lines 30-35).

***Allowable Subject Matter***

10. Claims 12-16 would be allowable if rewritten to overcome the objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

Claims 12-16 have allowable subject matter over the prior art for at least the reason that the prior art fails to teach and/or suggest “wherein the viewing device is connected to a mounting member by a pivot means” as set forth in the claimed combination.

Avizonis discloses a viewing device as set forth above but does not have wherein the viewing device is connected to a mounting member by a pivot means as claimed.

***Response to Arguments***

12. Applicant's arguments filed 29 April 2009 have been fully considered but they are not persuasive.

Applicant argues that even though Avizonis discloses that simple adjustments to the placement and angles of mirrors 7 and 9" may be made to achieve an angle range of approximately 60-120 degrees, it is not enabling disclosure for the claimed range and would not



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work as shown. The examiner respectfully disagrees. One of ordinary skill in the art can clearly discern that these angles are attainable by the device with minor adjustments as disclosed.

13. It is noted by the Examiner that the drawing, specification and claim objections made in the previous Office Action have been withdrawn due to amendment by the Applicant.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE FINEMAN whose telephone number is (571)272-2313. The examiner can normally be reached on Monday - Friday 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lee Fineman/  
Primary Examiner, Art Unit 2872  
20 July 2009